

REMARKS/ARGUMENTS

Drawing Objections

The drawings were objected to as failing to show every detail of the claimed invention. With respect to claim 73, the applicant agrees in some respects and disagrees in others. In order to advance prosecution, the applicant amended Figure 6 and claim 73. The amendment does not add new matter and is literally disclosed in the specification. A replacement page for the drawings is attached to this response.

With respect to claim 74 and 79, the applicant respectfully disagrees and points to 37 CFR 1.83, which recites in pertinent part: "...conventional features disclosed in the description and claims, where their detailed illustration is not essential for a proper understanding of the invention, should be illustrated in the drawing in the form of a graphical drawing symbol or a labeled representation (*e.g.*, a labeled rectangular box)...". The elements recited in claims 74 and 79 are clearly conventional features with corresponding description in the specification. The elements are clearly referred to in Figure 6 in a labeled representation. Therefore, the drawing objection with respect to claims 74 and 79 should be withdrawn.

35 USC § 112

Claims 79-85 were rejected under 35 USC § 112, second paragraph, as being indefinite for reciting a method that is dependent on an apparatus claim. The applicant agrees and has amended claims 79-85 accordingly.

35 USC § 102

Claims 71-77, 78-79, 81, and 84 were rejected as being anticipated over Coleman et al. (U.S. Pat. No. 4,622,974). The applicant respectfully disagrees and particularly points to claims 71 and 78 that expressly require that the apparatus is configured such that "...the opening is formed, the clarifying agent is delivered, and the light is emitted *when the apparatus is in a non-invasive position proximal to the sclera...*" and "...the clarifying agent is driven through the permeability barrier and the light is emitted to the area *when the apparatus is in a non-invasive position proximal to the tissue disposed below the permeability barrier..*", respectively.

In contrast, the *device of Coleman et al. must necessarily be inserted into the target tissue* to obtain any analyte, which is clearly described in Figure 1A, Figures 2A-C, and corresponding columns 3-6. The Office is invited to present evidence in the Coleman reference that such device would operate as claimed herein while the apparatus is in a non-invasive position relative to a target tissue, or that the rejection be withdrawn. Clearly, Coleman fails to teach each and every element of the present claims.

Claims 71-72, 75-76, 78-79, 81, 83-84, ad 86-90 were rejected as being anticipated over Martinez et al. (U.S. Pat. No. 4,222,375). The applicant once more respectfully disagrees and particularly points to claims 71, 78, and 86 that expressly require that the apparatus is configured such that "...the opening is formed, the clarifying agent is delivered, and the light is emitted *when the apparatus is in a non-invasive position proximal to the sclera...*", "...the clarifying agent is driven through the permeability barrier and the light is emitted to the area *when the apparatus is in a non-invasive position proximal to the tissue disposed below the permeability barrier..*", and "...the opening is formed, the clarifying agent is delivered, and the light is emitted *when the apparatus is in a non-invasive position proximal to the tissue disposed below the stratum corneum...*", respectively.

In contrast, and similar to the device of Coleman et al. above, Martinez's device *must also necessarily be inserted into a target tissue* to illuminate the target tissue, which is clearly described in the Figures and corresponding columns 3-4. It appears as though the Office would argue that the cannula would be a pore forming portion. Such assertion is entirely unsupported, and the alleged meaning is inconsistent with the ordinary meaning of that term. A cannula as defined by numerous medical dictionaries and as used in the art is a *tube for insertion into a duct or cavity*, wherein during insertion, the lumen of the tube is usually occupied by a trocar (a lancet-like insert used to cut and penetrate the target tissue, which is removed after the cannula is placed).

Furthermore, and with respect to the Office's assertion that the optical portion 12 would be the non-invasive optical portion, it is pointed out that *the claims require the entire apparatus, and not just the optical portion to be in a non-invasive and proximal position*. Such limitation

is clearly not taught by Martinez. Indeed, the contrary is taught (see *e.g.*, column 3, line 53 *et seq.*). Again, the Office is invited to present evidence in the Martinez reference of any teaching of the apparatus' non-invasive position, or that the rejection be withdrawn. Clearly, Martinez fails to teach each and every element of the present claims.

35 USC § 103

Claims 71-90 were rejected as being obvious over Coleman et al. in view of Chan (U.S. Pat. No. 6,275,726).

The position of the Office is unclear to the applicant. It appears as though the Examiner wants to state that Chan teaches all elements of the claimed apparatus with the exception of coaxial arrangement of the components, that Coleman would provide a suggestion or motivation for such arrangement, and that therefore the combination of Chan and Coleman would render the present claims obvious. Remarkably, *only claims 72 and 87 require coaxial arrangement. Thus, the reasoning for holding the remaining claims obvious is moot.*

Second, the Examiner's assertion that Chan discloses a pore forming portion (3:64-4:3) is off the mark at best. What Chan teaches in that paragraph is methods of delivery of replacement fluid, and not a pore forming portion of a device as presently claimed.

Third, the applicant invites the Office to explain the significance of the cited portions in Chan (1:50-65.....8:37-40) with regard to any teaching of a device as presently claimed having all three components and being configured as presently claimed. The portions cited by the Examiner are entirely insufficient to properly establish obviousness, especially in light of Coleman, which is also defective as already pointed out above. Clarification is requested, or the rejection should be withdrawn.

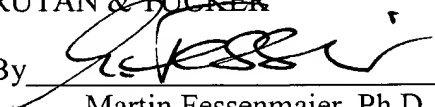
Appl. No. 09/777,640
Amdt. dated Mar. 14, 2005
Reply to Office action of Dec. 16, 2004
Annotated Sheet Showing Changes

In view of the present amendments and arguments, the applicant believes that all claims are now in condition for allowance. Therefore, the applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

RUTAN & TUCKER

By



Martin Fessenmaier, Ph.D.

Reg. No. 46,697

Tel.: (714) 641-5100